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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,863	02/09/2002	Wayne K. Kaim	KAIMAS-6	2420

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EXAMINER

SNIDER, THERESA T

ART UNIT	PAPER NUMBER
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1744

DATE MAILED: 03/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/072,863

Applicant(s)

KAIM, WAYNE K.

Examiner

Theresa T. Snider

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 2/9 & 7/18/02.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.  
4a) Of the above claim(s) 9-12 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-8 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 09 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2-3.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-8, drawn to a paper web cleaning apparatus, classified in class 15, subclass 309.1.
  - II. Claims 9-12, drawn to a method of cleaning a paper, classified in class 134, subclass 9.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another apparatus, such as one without a first buffing roll and a second buffing roll, and the apparatus as claimed can be used to practice another process such as one without the step of fabricating a core from a thin-walled cylinder.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation (by Ex. El-Arini) with Theodore Long on 6/24/2003 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-8. Affirmation of this election must be made by applicant in replying to this Office action. Claims

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9-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### *Drawings*

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because:

reference character "52" has been used to designate both cylinder ends(page 5, line 5) and cylindrical edges(page 5, line 6);

reference character "66" has been used to designate both circumferential radiused features(page 5, line 16) and radius conforming features(page 5, line 18);

reference character "36" has been used to designate both soft surface(page 4, line 15) and outer surface(page 6, line 3).

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 59(page 5, line 13).

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Specification*

7. The disclosure is objected to because of the following informalities:

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Exemplary of such:

Page 4, line 16, it is unclear as to what is meant by 'the air currents create interact'.

Appropriate correction is required.

*Claim Rejections - 35 USC § 112*

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Exemplary of such:

Claim 1, line 1, it is unclear as to what is meant by 'of the type';

Line 10, 'the ends' should be replaced with 'ends';

Line 11, it is believed 'hollow core surface' should be replaced with 'cylindrical surface' to correspond with line 8;

Line 11, it is unclear as to what constitutes 'soft'.

Claims 2-4, line 1, 'web' should be inserted after 'paper'.

Claim 4, line 1, it is believed 'hollow core surface' should be replaced with 'cylindrical surface' to correspond with line 8;

Line 2, it is unclear as to what constitutes 'rough'.

Claim 5, line 1, it is unclear as to what is meant by 'of the type';

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Line 6, 'made from a jacket material'(or the like) should be inserted after 'jacket' to provide for antecedence for line 7;

Line 8, it is unclear as to what constitutes 'soft'.

Claims 6-8, line 1, 'web' should be inserted after 'paper'.

Claim 8, line 2, it is unclear as to what constitutes 'rough'.

### *Claim Rejections - 35 USC § 103*

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 1- are rejected under 35 U.S.C. 103(a) as being unpatentable over The admitted State of the Prior Art as set forth in the preamble of the Jepson Claim(hereafter ASPA) in view of Hanish and Best & Co.

ASPA discloses a similar apparatus however fails to disclose the claimed roll structure.

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Hanish discloses a buffing roll having a hollow core with a core surface and mounted for rotation between stub shafts (fig. 1, #1,4).

Hanish discloses a jacket positioned about the surface wherein the jacket is held, not bonded, to the surface (col. 1, lines 27-31 and col. 2, lines 68-71 and 88-95).

Hanish discloses the jacket being a cloth or fabric however fails to disclose any specifics (col. 1, lines 27-28). Best & Co. discloses the use of cloth and fabrics on a buffing roll, wherein the cloth and fabric is felt or wool, materials known to be soft and have projecting fibers (see document). It would have been obvious to one of ordinary skill in the art to provide the cloth/fabric of Best & Co. in Hanish to allow for the provision of a jacket with a 'smooth polishing surface'.

It would have been obvious to one of ordinary skill in the art to provide the roll of Hanish in view of Best & Co. in ASPA to provide for a roll that is used with a moving web that will allow for cleaning without scratching/tearing of the web.

With respect to claims 2 and 6, Best & Co. discloses the fabric being wool (p.2).

With respect to claims 3 and 7, Hanish discloses the core being constructed of a metal (col. 2, lines 1-2). It would have been obvious to one of ordinary skill in the art to determine the most appropriate metal to use in ASPA in view of Hanish and Best & Co. to provide for the most durable construction.

With respect to claims 4 and 8, it would have been obvious to one of ordinary skill in the art to determine the most appropriate surface texture in ASPA in view of Hanish and Best & Co. to ensure that the jacket does not slide around on the surface during use of the roll.

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*Conclusion*

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ammons, Hormel, Shiroki et al. and Burch disclose roller cleaners with jackets.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theresa T. Snider whose telephone number is (571) 272-1277. The examiner can normally be reached on Monday-Wednesday-Friday (6:30AM-3:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J. Warden can be reached on (571) 272-1281. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Theresa T. Snider  
Primary Examiner  
Art Unit 1744

1/30/2004